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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,315	04/08/2004	Kristina Kershner	31011-1001	9713

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PEACOCK MYERS, P.C.
201 THIRD STREET, N.W.
SUITE 1340
ALBUQUERQUE, NM 87102

EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/821,315

Applicant(s)

KERSHNER, KRISTINA

Examiner

William M. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as set forth in the previous office action.

Response to Arguments

Applicant's arguments filed 10/20/06 have been fully considered but they are not persuasive.

With respect to the Guidelines issued by the Office, applicant should note that the Guidelines were issued to "assist USPTO personnel in the examination" (pg. 1, ln. 15). On pg. 2, ln. 10 of the Guidelines it is set forth that they do NOT "constitute substantive rule making and hence do not have the force and effect of law". In other words the Guidelines are not comprehensive nor are they binding upon an examiner. They are a tool to be used by examiner's in drafting a rejection under 101. In the instant case, both the MPEP and the Guidelines were used to set forth a rationale as to how the claims do not meet the requirements of 101.

With respect to the "rules to play a game", examiner never states that such is explicitly mentioned in the Guidelines such that applicant would be able to find it by means of a word search. The office action states the such are set forth "per se" and then goes into an analysis of how such claims are not subject matter recognized by 101 in conformance with the Guidelines. Applicant's reference to other patents cannot be used to overcome a grounds for rejection. Each application is subject to its own evidence and the law of its time.

The rejection under 101 was not made under the “human step” test. Examiner cites MPEP 2105 as the authority were applicant’s amount to a general manipulation of “people”. Ideally, the claims give appellant a monopoly on the people making up a first and second set of “people”. If such claims were patentable under 101, who would be the infringer of these claims? Would the “sets of people” be infringing? Would it be the game organizer? Its promoter? Clearly the intent and purpose of the prohibition of encompassing a human being as part of the subject matter as a whole is that one should not be granted the right to exclude people in general. Hence, this is evidence where the claims are not recognized under 101.

Further evidence that the claims are not recognized under 101 are that the claimed invention as a whole fails to be useful and accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. This requirement looks at the final results achieved from the claimed method. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). In evaluating what is accomplished by the claimed invention, one can see that the players remain the same and are not changed nor is anything produced by performing the steps of the claimed method.

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Further an interpretation, and evidence that the claims are not directed to statutory subject matter, is in the fact that the claims do not expressly or implicitly require performance of any of the steps by a machine (or physical apparatus) and such structure will not be read into the claims for the purpose of the statutory subject matter analysis. This requirement is one that the claims recite a "practical application, i.e., 'a useful, concrete and tangible result.'" *State St. Bank & Trust Co. v. Signature Fin. Group Inc.*, 149 F.3d 1368, 1371, 47 USPQ 2d 1596, 1600-01 (Fed. Cir. 1998). Further, evident that the claims are non-statutory is in that there exists no "transformation" to a different state or thing. The final result of applicant's invention is not tangible since a "group interaction" cannot be seen or felt. Such is not tangible in a person that a person can see, touch or feel the results. Lastly, the claims do not produce a result that is concrete. There is no evidence that each time the claimed invention is practiced by a group will produce the same results, i.e. there is no repeatability. Each time the method is performed a different writings and interactions will occur. Since different results will always occur by performing the claimed steps, the results are not concrete in that they cannot be repeated and are not predictable. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)

In the instant case, the claims do not require the manipulation of an apparatus, do not result in a transformation that is concrete and tangible result and fail to transform the subject matter to a something different than existed before the steps were performed.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


**WILLIAM M. PIERCE
PRIMARY EXAMINER**